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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/486,677 06/26/00 BEHLER

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HM12/0613

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EXAMINER

KEYS, R

ART UNIT	PAPER NUMBER
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1621

DATE MAILED:

06/13/01

*11*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/486,677

Applicant(s)

Behler et al.

Examiner  
Rosalynd Keys

Art Unit  
1621



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Apr 11, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 10, 14-26, and 30 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 10, 14-26, and 30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirem

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20)  Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Status of Claims***

1. Claims 10, 14-26 and 30 are pending.

Claims 10, 14-26 and 30 are rejected.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10, 14-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,172,931.

GB 1,172,931 teach nonionic surface active agents (surfactants) having a random mixture of oxypropylene and oxyethylene groups (see page 2, lines 15-35, 75-80 and 105-123; page 3, lines 2-38; and Examples IV and V).

GB 1,172,931 fail to teach the ranges of EO and PO disclosed in the instant claims. However, on page 3, lines 20-22 GB '931 teaches a weight ratio of propylene oxide to ethylene oxide ranges from 0.85:1 to 2.75:1. In the instant application the weight ratio of propylene oxide to ethylene oxide ranges from 0.4:1 to 0.83:1. The weight ratios of GB 1,172,931 and the instant invention are close enough that one having ordinary skill in the art would have expected them to produce the same results. Further, it is well-established that merely selecting

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proportions and ranges is not patentable absent a showing of criticality. In re Becket, 33 U.S.P.Q. 33 (C.C.P.A. 1937). In re Russell, 439 F.2d 1228, 169 U.S.P.Q. 426 (C.C.P.A. 1971).

GB 1,172,931 fail to teach the use of the surfactants with agrochemicals and pesticides. However, the use of surfactants with agrochemicals and pesticides is well known in the art. Thus, one having ordinary skill in the art at the time the invention was made would have found the use of the nonionic surfactants of GB 1,172,931 in combination with agrochemicals and pesticides obvious.

5. Claims 10, 14-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-303825.

JP 7-303825 discloses a nonionic surfactant with good fluidity at low temperatures and an excellent cleaning performance. These nonionic surfactants are obtained by random addition of, on an average, 5-15 moles of ethylene oxide and 0.3-5.0 moles of propylene oxide (see claim 1, pages 2-4 and Table 1).

JP 7-303825 does not exemplify the claimed ranges of EO and PO. However, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches to a person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). The EO and PO ranges disclosed in the specification of JP 7-303825 overlap with the claimed EO and PO ranges. In the instant application the EO value ranges from about 3 to about 5 and the PO value ranges from about 2 to about 2.5. JP '825 teaches using 5-15 moles of EO and 0.3 to 5 moles of PO. It has been held that in the case where claimed ranges "overlap

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or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990); *In re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997).

JP 7-303825 fails to teach the use of the surfactants with agrochemicals and pesticides. However, the use of surfactants with agrochemicals and pesticides is well known in the art. Thus, one having ordinary skill in the art at the time the invention was made would have found the use of the nonionic surfactants of JP 7-303825 in combination with agrochemicals and pesticides obvious.

#### ***Response to Amendments***

##### **Claim Rejections - 35 USC § 102**

6. The rejection of claims 10-24 and 27-29 under 35 U.S.C. 102(b) as being anticipated by GB 1,172,931 is withdrawn due to the amendment to the claim wherein the value of n and m has been changed.
7. The rejection of claims 10-25 and 27-30 under 35 U.S.C. 102(b) as being anticipated by Compton et al. (US 4,093,418) is withdrawn due to the amendment to the claim wherein the value of n and m has been changed.
8. The rejection of claims 10-13, 15-18, 20-24 and 27-29 under 35 U.S.C. 102(b) as being anticipated by Stoeckigt et al. (US 4,280,919) is withdrawn due to the amendment to the claim wherein the value of n and m has been changed.

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9. The rejection of claims 10-13, 15-18, 20-25 and 27-29 under 35 U.S.C. 102(b) as being anticipated by JP 7-303825 is withdrawn due to the amendment to the claim wherein the value of n and m has been changed.

***Response to Arguments***

10. The rejection of claim 26 under 35 U.S.C. 103(a) as being unpatentable over Compton et al. (US 4,093,418) because Compton et al. fail to teach or fairly suggest the claimed ranges of ethoxylate groups and propoxylate groups.

11. The rejection of claims 14, 19, 25, 26 and 30 under 35 U.S.C. 103(a) as being unpatentable over Stoeckigt et al. (US 4,280,919) is withdrawn because Stoeckigt et al. is directed to non-random, block polymers, whereas the instant claims are directed to random polymers. Thus, Stoeckigt et al. fail to teach or fairly suggest every element of the claimed invention.

12. The rejection of claims 25, 26 and 30 under 35 U.S.C. 103(a) as being unpatentable over GB 1,172,931 is maintained.

Applicants' arguments filed April 11, 2001 have been fully considered but they are not persuasive.

The Applicants' argue that GB '931 does not teach or suggest the claimed average number of ethoxylate and propoxylate groups. This argument is not persuasive because on page 3, lines 20-22 GB '931 teaches that the weight ratio of propylene oxide to ethylene oxide ranges from 0.85:1 to 2.75:1. In the instant application the weight ratio of propylene oxide to ethylene oxide ranges from 0.4:1 to 0.83:1. Although these weight ratios do not overlap, they are close

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enough that one having ordinary skill in the art would have expected them to produce the same results.

The Applicants' argue that GB '931 specifically teaches that more propoxylate than ethoxylate is preferred. This argument is not persuasive because it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches to a person of ordinary skill in the art.

*In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). In the instant case GB '931 teaches that the ratio of propylene oxide to ethylene oxide can vary from 0.85:1 to 2.75:1. Thus, when evaluated for what GB '931 teaches as a whole the amount of propoxylate can be less than the amount of ethoxylate.

The Applicants' argue that GB '931 is not directed to improving low temperature behavior. This argument is not persuasive because it is not necessary that the prior art achieve the same advantage or result discovered by applicants. The prior art need only suggest the claimed modification, i.e., in the instant case the value of EO and PO.

For the above reasons, this rejection is maintained.

13. The rejection of claims 14, 19, 26 and 30 under 35 U.S.C. 103(a) as being unpatentable over JP 7-303825 is maintained.

Applicants' arguments filed April 11, 2001 have been fully considered but they are not persuasive.

The Applicants argue that JP '825 suggests much higher degrees of alkoxylation than the claimed random fatty alcohol alkoxylates and that JP '825 does not contain any teaching or

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suggestion which would motivate one of ordinary skill in the art to use a lower degree of alkoxylation. This argument is not persuasive because again as stated above it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). The Applicants arguments are directed to Examples 1-3 of JP '825 and not the entire disclosure. In the instant application the EO value ranges from about 3 to about 5 and the PO value ranges from about 2 to about 2.5. In claim 1, JP '825 teaches using 5-15 moles of EO and 0.3 to 5 moles of PO. Thus, the EO and PO ranges taught in JP '825 and those of the instant invention overlap. It has been held that in the case where claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990); *In re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997).

For the above reasons this rejection is maintained.

The Applicants argue that they have a showing of unexpected and advantageous results in terms of significantly improved low temperature behavior. The Examiner disagrees that unexpected results have been shown over the prior art. The Applicants have not done a side-by-side comparison between the instant invention and the closest prior art of record, i.e., JP '825.

If the applicants intend to rely on unexpected or unforeseen results, attention is invited to M.P.E.P. § 716. Absent clear, convincing, side-by-side data demonstrating unobviousness vis-a-

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vis the prior art commensurate with the scope of protection sought, the claims are considered prima facie obvious. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range in order to show criticality of the claimed range. *In re Hill*, 128 USPQ 197 (CCPA 1960).

#### ***Conclusion***

14. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is (703) 308-4633. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-1235. The Examiner's supervisor, Johann Richter, may be reached at (703) 308-4532. Communications may now be transmitted via FAX directly to group 1600. The official group 1600 FAX machine number is (703) 308-4556.



ROSALYND KEYS  
PRIMARY EXAMINER  
GROUP 1600  
June 13, 2001